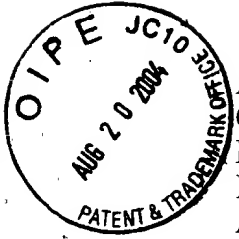


E 524133243

#23
9/10/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Application Serial No.09/767,512
Confirmation No.3413
Filing Date1/22/01
Inventorship Vong et al.
Assignee..... Microsoft Corporation
Group Art Unit2182
ExaminerC. Shin
Attorney's Docket No.MS1-155USC3
Title: Handheld Computing Device With External Notification System

APPEAL BRIEF

RECEIVED

AUG 26 2004

Technology Center 2100

To: Mail Stop Appeal Brief – Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

From: Michael K. Colby
Customer No.: 22801

Sir:

Appellant appeals the Office's Final Action dated January 20th, 2004, for
the above-identified application. Favorable consideration is respectfully requested.

08/24/2004 CNGUYEN 00000009 120769 09767512

02 FC:1402 330.00 DA

REAL PARTY IN INTEREST

The real party in interest in the present matter is the Microsoft Corporation of Redmond, WA, USA.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to Appellant or Appellant's undersigned representative that would directly affect, or be directly affected by, the outcome of the present Appeal.

STATUS OF CLAIMS

Claims 1-39 were originally filed. Claims 40-47 were previously added. Claims 1-17, 21-22, 24-40, and 47 were previously canceled. Claims 18, 19, 20, and 23 were previously amended. Thus, Claims 18-20, 23, and 41-46 are pending.

Claims 18-20, 23, and 41-46 stand rejected.

This Appeal is made to the rejection of Claims 18-20, 23, and 41-46, which are set forth in the Appendix of Claims on Appeal.

Claims 18-20 and 42-44 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,552,967 to Seto et al. (hereinafter, "Seto").

Claims 23, 41, and 45-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Seto in view of U.S. Patent No. 6,041,215 to Maddrell et al. (hereinafter, "Maddrell"), U.S. Patent No. 4,056,701 to Weber (hereinafter,

“Weber”), U.S. Patent No. 4,454,596 to Wunsch et al. (hereinafter, “Wunsch”), or U.S. Patent No. 5,606,712 to Hidaka (hereinafter, “Hidaka”).

STATUS OF AMENDMENTS

The Final Office Action, which is the subject of this Appeal, was mailed on January 20th, 2004 (herein the “Final Office Action”).

The Office mailed an Advisory Action on April 14th, 2004, after which Appellant filed a Notice of Appeal dated May 20th, 2004.

No amendments have been filed subsequent to the Final Office Action.

SUMMARY OF THE INVENTION

The claimed embodiments are directed toward a portable, handheld computing device having a light emitting device capable of being activated upon occurrence of an event to notify a user. The present summary references the example illustrated in Figures 1, 2a, 2b, and 2c of this patent application.

Figure 1 of the subject application illustrates an exemplary handheld computing device 20 having a casing 22 with a cover or lid 24, a base 26, and an externally mounted light emitting device (an LED 40).

Figures 2a, 2b, and 2c further illustrate the exemplary light emitting device. When activated as a result of an event, LED 40 is illuminated or made to flash. (Page 7, lines 6-7.) The LED is mounted on the external surface of the handheld

computing device in a location at which the user can view the light from different angles and sides. (Page 7, lines 9-11.) The LED can be positioned to be seen when lid 24 is open or closed. (Page 7, lines 11-12.)

LED 40 is positioned on an upper surface 42 of casing 22 or lid 24 and wraps around an upper corner to extend onto an end surface 50. (*See* page 7, line 17, to page 8, line 1 and Figures 1-2.) The LED is raised on the end surface to be visible from the front. (*Id.*) In this manner, the LED can be viewed when the case is closed, either from above by viewing the LED portion on the upper surface (for instance when the handheld computing device is sitting on a desk), or from the side by viewing the LED portion on the end surface (for instance when the handheld computing device is slid upright into a shirt pocket, purse, or briefcase). (*Id.*) Additionally, the LED can be viewed when the case is open by viewing the raised portion of the LED on end surface 50. (*Id.*)

ISSUES

The issues presented for appeal are:

- 1) the rejection of Claims 18-20 and 42-44 under 35 U.S.C. §102(e) as being anticipated by Seto; and
- 2) the rejection of Claims 23, 41, and 45-46 under 35 U.S.C. §103(a) as being unpatentable over Seto in view of Maddrell, Weber, Wunsch, or Hidaka.

GROUPING OF CLAIMS

The rejections presented in the Final Office Action are addressed below as they pertain to the following groups of claims:

Group I: Claims 18, 23, and 41;

Group II: Claim 19;

Group III: Claim 20; and

Group IV: Claims 42-46.

Appellant submits that the claims under appeal do not stand or fall together. Each of the groups are separately patentable because they recite different, patentably distinct subject matter: Group I recites a light emitting device mounted on a casing and positioned on an upper surface of the casing and wrapping around to and being raised on an end surface; Group II recites an light emitting device mounted and raised on a lid; Group III recites a light emitting device mounted on a casing, positioned on an upper surface of a lid, and wrapping around to an end surface so that the light emitting device is visible from opposing side surfaces and opposing end surfaces when the lid is opened or closed; and Group IV recites a light emitting device mounted on a casing having upper and lower surfaces, front and back side surfaces, and opposing end surfaces and positioned such that it is visible from the upper surface, one of the side surfaces, and one of the end surfaces. The separate patentability of these groups of claims is further illuminated in the Argument section below.

ARGUMENT

Group I: Claims 18, 23, and 41.

1) The rejection of Claim 18 under 35 U.S.C. §102(e)

Appellant respectfully submits that Claim 18 is not anticipated by Seto.

Anticipation is a legal term of art. Appellant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include each and every element as set forth in the claim (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987); *and see* MPEP §2131); and (ii) the teachings of the reference cannot be modified (*Pfizer, Inc. v. Int'l Rectifier Corp.*, 545 F. Supp. 486, 522, 207 USPQ 397 (C.D. Cal. 1980), *aff'd*, 685 F.2d 357 (9th Cir. 1982), *cert. denied*, 459 U.S. 1172 (1983)); (“A prior art publication cannot be modified by the knowledge of those skilled in the art for the purposes of anticipation”); *and see* MPEP §706.02, stating that “No question of obviousness is present” in conjunction with anticipation).

As part of Appellant’s argument, Appellant will address the Office’s rejections in the Final Office Action and the Office’s response to Appellant’s argument (presented in a Response dated September 30th, 2003). Appellant presents Claim 18 and then turns first to the Office’s rejection in the Final Office Action.

Claim 18, previously amended, recites a portable handheld computing device comprising:

- a casing having upper and lower surfaces, opposing front and back side surfaces, and opposing end surfaces, the ends being dimensionally shorter than the front and back side surfaces; and
- a light emitting device mounted externally on the casing, the light emitting device being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces, the light emitting device being activated upon occurrence of an event to notify a user.

The Office, at paragraph 5 of the Final Office Action, argues that feature 254 shown in Figure 1 of Seto teaches a “light emitting device (LED) mounted externally on the casing, the LED being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces.” Appellant respectfully submits that the feature 254 of Seto does not teach this element of Claim 18.

The cited indicator 254 of Seto is not positioned on an upper surface and wrapping around an end surface. The cited indicator 254 is located at a meeting point of a front wall 8a and a top wall 8b of a section 8. (*See Seto*, col. 23, lines 57-68, col. 10, lines 38-44, and Fig. 1.) These walls, rather than wrapping to an end surface, are integral with a top cover 6, as shown in Figs. 1, 7 and 8. (*See also Seto* at col. 23, lines 57-68 and col. 10, lines 41-44.) In sum, the cited indicator 254 simply does not wrap around to or even contact an end surface.

Also, the cited indicator 254 of Seto is not raised on an end surface; Seto discloses the indicator 254 as flush with the front wall 8a and the top wall 8b of section 8. (*See supra*, especially Fig. 7.)

For these reasons, Appellant respectfully submits that the Office has failed to establish a *prima facie* case showing that Seto discloses each and every element set forth in Claim 18, as required by the Federal Circuit in *Verdegaal, supra*.

Appellant now turns to the Office's response in the Final Office Action, which is directed to Appellant's argument presented in a Response dated September 30th, 2003. Because Appellant will refer to the Office's response, Appellant provides it below for context.

- a. On page 7, lines 3-15, as for the claim 18, the examiner disagrees with the applicant's interpretations of the claimed invention. By looking at the figure 1, instead/verses of figure 8, one can interpret the claimed "ends" & surfaces" different from the applicant, when the screen portion/section/lid (3) is opened. In other words, one can interpret "ends" being surfaces of (8/8b) of figure 1. With the above interpretations, the teachings of the Seto anticipates, not clearly anticipates, (reads on the Seto reference) the present claimed invention. One can also see the limitations regarding the wrap around and raised teachings from figure 1 of the Seto reference, when given the above interpretations. Furthermore, when it come to the functionality of the claimed limitations, the Seto clearly teaches all of the claimed "activated upon a occurrence of an event to notify a user" function.
- b. On pages 7-10, as for the claims 19, 20 & 42-44 the above examiner's broad interpretation and discussions are similarly applied.
- c. On pages 11-12, as for the claim 23, the examiner disagrees with the applicant's argument regarding the "designer's choice" argument, as can be seen from the Secondary references Weber, Wunsch & Maddrell, One can easily recognize the commonly utilized type of LED integrated button for activation, deactivation & event notification claimed functions for the design choice substitution without having any differences in terms of performing/supporting or teaching the claimed combination limitations.

- d. On pages 12-13, as for the claims 41 & 45-46, the above discussions (e.g., paragraph 2a-2c are similarly applied.
- e. The examiner suggests the applicant to carefully review all of the Examiner cited references before responding to this office action. The examiner relies on the cited art for the well known prior art/common knowledge/support of the official notice.
- f. In summary, the examiner believes that the arguments between the applicant and the examiner caused by the difference in the interpretations of the present claims & the teachings of the cited references. Therefore, the examiner suggests the applicant carefully consider the possible , more broad, interpretations that can be applied to the claims and the teachings of cited references.

Appellant respectfully submits that the Office has impermissibly modified the teaching of Seto to reject Claim 18 under 102(e), which is prohibited by the Federal Circuit in *Pfizer, supra*. Appellant also argues below that, even if Seto is impermissibly modified to reject Claim 18 under 102(e), Seto still fails to disclose the elements recited in Claim 18.

The Office, in its response to Appellant's arguments, asserts in paragraph 2a of the Final Office Action that the front wall 8a and the top wall 8b of section 8 can be interpreted to disclose the upper surface and the end surface recited in Claim 18. (The Office does not clearly set this out, but this is either inherent in the Office's argument or the Office's argument does not make sense.) Following this assumption, the Office then writes that "the teachings of the Seto [reference] anticipates [sic]... the present claimed invention." (Final Office Action, paragraph 2a.)

The Office's interpretation of Seto modifies Seto in an attempt to show that the front wall 8a and the top wall 8b of section 8 disclose the upper surface and the end surface recited in Claim 18. As has been set forth above, these features of Seto do not disclose the elements of Claim 18 without modification as neither the front wall 8a nor the top wall 8b of Seto disclose an opposing end surface.

Even if the Office carves up the housing 4 of Seto to make section 8 a stand-alone device, the resulting device does not teach or disclose the upper surface and end surfaces of Claim 18. (*See Seto*, Figs. 1, 7, and 8.) The Office interprets section 8 such that the front wall 8a teaches the upper surface of Claim 18 and the top wall 8b teaches the end surfaces of Claim 18. But neither the front wall 8a nor the top wall 8b teach or disclose "a casing having upper and lower surfaces, opposing front and back side surfaces, and opposing end surfaces, the ends being dimensionally shorter than the front and back side surfaces," as required by Claim 18. As is clearly shown in Fig. 1 of Seto, the top wall 8b of section 8 is not dimensionally shorter than anything approximating a front and back side surface of section 8.

Further, the Office continues to rely on this interpretation, writing that Figure 1 of Seto teaches a raised LED. (Final Office Action, paragraph 5.) Again, even if the Office carves up the housing 4 of Figure 1 in an attempt to show the claimed invention, the resulting device does not teach or disclose a light emitting device being positioned on the upper surface and wrapping around to and being

raised on one of the end surfaces, as required by Claim 18. Rather, Seto discloses in Figure 7 that the indicator 254 is flush with the front wall 8a and the top wall 8b of section 8. (See Seto, Fig. 7.) Following the Office's interpretation of the front wall 8a and the top wall 8b teaching the upper surface and an end surface, the indicator 254 shown is flush with the front wall 8a and the top wall 8b. It cannot, therefore, also be "raised on one of the end surfaces," as required by Claim 18.

For at least these reasons, the Office has i) failed to establish that each and every element of Claim 18 is disclosed by Seto, ii) impermissibly modified Seto, or iii) failed to establish that Seto, even if modified, discloses every element of Claim 18.

Thus, the apparatus cited by the Office does not disclose a light emitting device being positioned on the upper surface and *wrapping around to and being raised on one of the end surfaces*, as Claim 18 requires.

Group I, continued.

2) The rejection of Claims 23 and 41 under 35 U.S.C. §103(a)

Appellant respectfully submits that Claims 23 and 41 are patentable over Seto in view of Maddrell, Weber, Wunsch, or Hidaka.

Claims 23 and 41 depend from Claim 18 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in Claim 18, are neither

disclosed nor suggested in references of record, either singly or in combination with one another.

Also, the Office admits differences between what Seto discloses and what the claims recite, stating that these differences are “Design Choice” matters. In support of this rejection, the Office takes official notice on design choice matters for off-button integration and light-emitting device and button combinations. The Office writes that Maddrell, Weber, Wunsch, and Hidaka demonstrate these design choices. (Final Office Action, paragraph 7.)

The Office also attempts to establish well-known prior art, writing that “the shape, size, and location of such LED is clearly within the choice of the designer, as supported by the examiner cited prior art of record and more not yet cited but the examiner would like [to] give official notice on such well known design choices.” (Final Office Action, paragraph 3.)

Rejection of claims as a “design choice” matter are appropriate when a change in an element’s size or proportion “would not perform differently than the prior art device.” (*Gardner v. TEC Systems, Inc.* 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).)

Design-choice rejections are not appropriate, however, when a claimed structure and the function it performs are different from the prior art. (*See In re Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992) (finding of “obvious design

choice” precluded where the claimed structure and the function it performs are different from the prior art).)

Appellant respectfully submits that the Office has failed to demonstrate that Maddrell, Weber, Wunsch, and Hidaka provide the deficiencies in the teaching of Seto sufficient to render Claim 23 or 41 obvious. Also, to the extent that the Office relies on design choice to provide these deficiencies, the Office has erred because the claimed structure and function of Claim 23 or 41 are different from the prior art cited by the Office.

Specifically, Weber and Wunsch fail to teach or disclose a “light emitting device being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces,” as required by Claim 18 on which Claim 23 depends. Instead, Weber discloses a “low profile, lighted, push button switch” shown mounted such that it does not wrap around an end surface. (*See Weber*, Fig. 4 and Abstract.) And, Wunsch discloses “lighted push buttons... mounted on a board” that do not wrap around an end surface. (*See Wunsch*, Figs. 1, 2, 3a, 3b, 5, 13, and 14; and Abstract.)

Likewise, Maddrell fails to teach or disclose a “light emitting device being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces,” as required by Claim 18 on which Claim 23 depends. Instead, Maddrell discloses a visual indicia flush with a single surface. (*See Maddrell*, Figs. 1, 7, and 19; and Abstract.)

Finally, Hidaka fails to teach or disclose a “light emitting device being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces,” as required by Claim 18 on which Claim 23 depends. Instead, Hidaka discloses an “LED cover 18... provided at one side edge portion of the cover 2,” showing that the device of Hidaka is flush with a surface, rather than being raised. (*See Hidaka*, column 5, lines 29-31 and 55-59 and Fig. 1.)

The Office, in its response to Appellant’s arguments, writes in paragraph 2c of the Final Office Action (set forth above) that the secondary references of Weber, Wunsch, and Maddrell describe “commonly utilized type of LED integrated button for activation, deactivation & event notification claimed functions for the design choice substitution without having any differences in terms of performing/supporting or teaching the claimed combination limitations.” This response does not, however, address the deficiencies in the Office’s rejection noted above for Claim 23 or Claim 18, on which Claim 23 depends.

In sum, Appellant respectfully submits that these references do not provide the deficiencies of Seto. They do not teach or disclose a “light emitting device being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces,” as required by Claim 18. They do not teach or disclose the claimed structure or function, thereby precluding design choice as a means by which the Office can provide these deficiencies under *In re Gal*. They do not

teach or disclose a device that, with a changed size or proportion, would cause the device to perform as the claimed structure performs, as required by *Gardner*.

Dependent Claim 41, previously added, is allowable at least by virtue of its dependency on dependent Claim 23 and base Claim 18. This claim is also allowable for its own recited features that, in combination with those recited in Claims 18 and 23, are neither disclosed nor suggested in references of record, either singly or in combination with one another.

Group II: Claim 19.

3) The rejection of Claim 19 under 35 U.S.C. §102(e)

Appellant respectfully submits that Claim 19 is not anticipated by Seto.

Claim 19, previously amended, recites a portable handheld computing device comprising:

- a casing having a base and a lid; and
- a light emitting device mounted externally and raised on the lid, the light emitting device being activated upon occurrence of an event to notify a user.

The Office argues that feature 254 of Figure 1 of Seto, along with features shown in Figures 1 and 8 of Seto, anticipate Claim 19. (Paragraph 5 of Final Office Action.)

Seto fails to disclose a light emitting device mounted on a lid. The indicator 254 cited by the Office is in the housing 4 of the base unit 2, shown in

Figure 1 of Seto. But the base unit 2 is not a lid. (*See Seto, Figure 1.*) Seto teaches “a display unit 3 ... hinged to the base unit 2,” which is arguably a lid. (*See Seto, Figure 1 and col. 10, lines 18-20.*) The indicator 254 relied on by the Office, however, is not in the display unit 3—it is in the base unit 2. Thus, Seto fails to disclose a light emitting device mounted on a lid.

Also, the indicator 254 cited by the Office is not “raised.” As set forth in the arguments above, Seto teaches that the indicator 254 is flush with its surrounding surfaces. (*See Section 1, supra.*)

The Office, in its response to Appellant’s arguments, writes in paragraph 2b of the Final Office Action that its argument of paragraph 2a is similarly applied for Claim 19. (*See Final Office Action, paragraph 2b, supra.*)

As set forth above, however, paragraph 2a does not establish that Seto teaches or discloses “a light emitting device mounted externally and raised on the lid,” as required by Claim 19. (*See Section 1, supra.*)

Appellant respectfully submits that the Office has not established a *prima facie* case showing that Seto discloses a light emitting device *mounted externally and raised on the lid*, as required by Claim 19.

Group III: Claim 20.

4) The rejection of Claim 20 under 35 U.S.C. §102(e)

Appellant respectfully submits that Claim 20 is not anticipated by Seto.

Claim 20, previously amended, recites a portable handheld computing device comprising:

- a casing having a base and a lid that opens and closes relative to the base, the lid having an upper surface, opposing side surfaces, and opposing end surfaces; and
- a light emitting device mounted externally on the casing, the light emitting device being activated upon occurrence of an event to notify a user, positioned on the upper surface of the lid, and wrapping around to one of the end surfaces so that the light emitting device is visible from both opposing side surfaces and both opposing end surfaces when the lid is opened or closed.

The Office argues that Figures 1 and 8 of Seto (presumably with the feature 254) disclose an LED “positioned on the upper surface of the lid, and wrapping around to one of the end surfaces so that the LED is visible from both opposing side surfaces and both opposing end surfaces when the lid is opened or closed.” (Paragraph 5 of Final Office Action.)

Appellant respectfully submits that the Office, in relying on Seto, has failed to disclose an LED that is “visible from both opposing side surfaces and both opposing end surfaces when the lid is opened or closed.” Seto, rather, teaches that the indicator 254, as shown in Figures 1 and 8, is not visible from end surfaces when the display 3 is closed or from any side surface, whether the display 3 is opened or closed. (*See Seto, Figures 1 and 8.*)

Thus, the apparatus cited by the Office does not disclose “a light emitting device ... positioned on the upper surface of the lid, and wrapping around to one of the end surfaces so that the light emitting device is visible from both opposing

side surfaces and both opposing end surfaces when the lid is opened or closed,” as required by Claim 20.

The Office, in its response to Appellant’s arguments, writes in paragraph 2b (set forth above) of the Final Office Action that its argument of paragraph 2a is similarly applied for Claim 20. (*See* Final Office Action, paragraph 2b.)

As argued above, Seto, using the Office’s current interpretation or otherwise, does not teach or disclose a “light emitting device... positioned on the upper surface of the lid,” as required by Claim 20. (*See* Section 1, *supra*.)

Also as argued above, Seto does not disclose a “light emitting device... positioned on the upper surface... and wrapping around to one of the end surfaces,” as required by Claim 20. (*See* Section 1, *supra*.)

Group IV: Claims 42-46.

5) The rejection of Claims 42-44 under 35 U.S.C. §102(e)

Appellant respectfully submits that Claims 42-44 are not anticipated by Seto.

Claim 42, previously added, recites a portable handheld computing device comprising:

- a casing having upper and lower surfaces, front and back side surfaces, and opposing end surfaces; and
- a light emitting device mounted externally on the casing,
- wherein the light emitting device is:
- activated upon occurrence of an event to notify a user; and

- positioned such that the light emitting device is visible from the upper surface, one of the side surfaces, and one of the end surfaces.

The Office argues that features shown in Figures 1 and 8 of Seto (presumably the feature 254) teach “all of the functional equivalent claimed limitations” of claims 42-44. (Paragraph 5 of Final Office Action.)

Appellant respectfully submits that Seto does not disclose a light emitting device positioned such that “the light emitting device is visible from the upper surface, one of the side surfaces, and one of the end surfaces” as required by Claim 42.

The claimed light emitting device performs differently than the indicator 254 disclosed by Seto. As is shown in Figures 1 and 8, Seto does not disclose a light emitting device that performs the function of being “visible from ... one of the side surfaces, and one of the end surfaces.” (*See* Seto, Figures 1 and 8.) The indicator 254 of Seto, rather, teaches an LED visible by a viewer looking in a direction perpendicular to a side wall 5b (the side wall furthest from the opened display unit 3 shown in Figure 1) but not visible from any of the other side walls 5b. (*See* Seto, col. 10, lines 28-37 and Figs. 1, 2, and 6.) Seto simply does not disclose that the indicator 254 is visible from either of the other two side walls 5b, marked in Figures 2 and 6. (*Id.*) Seto, therefore, does not disclose a light emitting device visible from both a side surface and an end surface. At best, Seto arguably

only discloses an LED visible from either a side surface or an end surface, but not both.

Further, when the display unit 3 is closed, the indicator 254 is not visible when viewed from a direction perpendicular to any of the side walls 5b. (*Id.*) Thus, the claimed light emitting device performs differently than the apparatus disclosed in Seto.

Dependent Claims 43-44, previously added, depend from Claim 42 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in Claim 42, are neither disclosed nor suggested in references of record, either singly or in combination with one another.

Group IV: continued.

6) The rejection of Claims 45-46 under 35 U.S.C. §103(a)

Appellant respectfully submits that Claims 45-46 are patentable over Seto in view of Maddrell, Weber, Wunsch, or Hidaka.

First, dependent Claims 45-46, previously added, depend from Claim 42 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in claim 42, are neither disclosed nor suggested in references of record, either singly or in combination with one another.

Second, Appellant respectfully submits that the structures of Claims 45 and 46 and the functions they perform are different from the prior art of record. The Office has rejected these claims in part on the basis of a design choice (Final Office Action, paragraph 7), which is not appropriate when a claimed structure and the function it performs are different from the prior art. (*See In re Gal, supra.*)

The Office admits that Seto “does not expressly disclose ... the physical situations of the LED.” (Final Office Action, paragraph 7.) To address this deficiency, the Office states that “such difference in limitation is a design choice matter to one having ordinary skill in the art,” taking “official notice on such design choice matter” in rejecting Claims 45-46. (*Id.*)

The prior art relied on by the Office in rejecting Claims 45 and 46, that of Seto, Weber, Wunsch, Maddrell, and Hidaka, do not teach the structures of Claims 45 and 46 and the functions they perform. The Office admits that Seto does not disclose the physical situations of the LED. The Office refers to Weber, Wunsch, Maddrell, and Hidaka, but has not shown that these references teach a light emitting device having the structure and function recited in Claim 45 or 46. Specifically, Weber, Wunsch, Maddrell, and Hidaka do not teach the structure of a light emitting device having a function “such that the light emitting device is visible from the upper surface, one of the side surfaces, and one of the end surfaces” and “wherein the light emitting device is further visible from the bottom

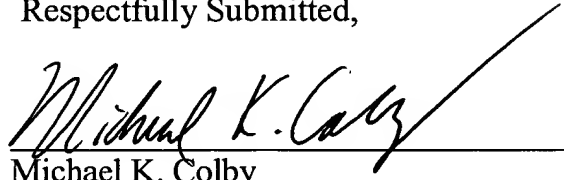
surface” or “wherein the light emitting device is further visible from the bottom surface, another end surface, and another side surface,” as required by Claims 45 and 46, respectively. As such, the prior art relied on by the Office does not teach the claimed structures and the functions they perform as required by these claims. To the extent that the Office relies on a design choice to provide this deficiency, the Office does so improperly, as the art relied on and the structures and functions of Claims 45 and 46 are different.

For these reasons, Appellant respectfully submits that the Office has failed to establish a *prima facie* case of obviousness in rejecting Claims 45-46.

Conclusion

The Office's basis and supporting rationale for the 35 U.S.C. §102 and §103 rejections are not supported by relevant authority, are inconsistent with established examination practice, and/or do not comport with the teachings of the cited references. Appellant respectfully requests that the rejections be overturned and that pending Claims 18-20, 23, and 41-46 be allowed to issue.

Respectfully Submitted,



Michael K. Colby
Reg. No. 45,816

LEE & HAYES, PLLC
421 W. Riverside Avenue, Suite 500
Spokane, WA 99201
(509) 324-9256 ext. 240

APPENDIX OF CLAIMS ON APPEAL

18. (Previously Presented): A portable handheld computing device comprising:

a casing having upper and lower surfaces, opposing front and back side surfaces, and opposing end surfaces, the ends being dimensionally shorter than the front and back side surfaces; and

a light emitting device mounted externally on the casing, the light emitting device being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces, the light emitting device being activated upon occurrence of an event to notify a user.

19. (Previously Presented): A portable handheld computing device comprising:

a casing having a base and a lid; and

a light emitting device mounted externally and raised on the lid, the light emitting device being activated upon occurrence of an event to notify a user.

20. (Previously Presented): A portable handheld computing device comprising:

a casing having a base and a lid that opens and closes relative to the base, the lid having an upper surface, opposing side surfaces, and opposing end surfaces; and

a light emitting device mounted externally on the casing, the light emitting device being activated upon occurrence of an event to notify a user, positioned on the upper surface of the lid, and wrapping around to one of the end surfaces so that the light emitting device is visible from both opposing side surfaces and both opposing end surfaces when the lid is opened or closed.

23. (Previously Presented): A portable handheld computing device as recited in claim 18, wherein:

the light emitting device includes a button to deactivate the light emitting device, the button being integrated with the light emitting device.

41. (Previously Presented): A portable handheld computing device as recited in claim 23, wherein:

the light emitting device emits light until the button is activated.

42. (Previously Presented): A portable handheld computing device comprising:

- a casing having upper and lower surfaces, front and back side surfaces, and opposing end surfaces; and
- a light emitting device mounted externally on the casing,

wherein the light emitting device is:

- activated upon occurrence of an event to notify a user; and
- positioned such that the light emitting device is visible from the upper surface, one of the side surfaces, and one of the end surfaces.

43. (Previously Presented): A portable handheld computing device as recited in claim 42, wherein the light emitting device is further visible from another end surface."

44. (Previously Presented): A portable handheld computing device as recited in claim 42, wherein the light emitting device is further visible from another side surface.

45. (Previously Presented): A portable handheld computing device as recited in claim 42, wherein the light emitting device is further visible from the bottom surface.

46. (Previously Presented): A portable handheld computing device as recited in claim 42, wherein the light emitting device is further visible from the bottom surface, another end surface, and another side surface.